

ESTTA Tracking number: **ESTTA602959**

Filing date: **05/07/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Asco Group Limited
Granted to Date of previous extension	05/07/2014
Address	Chancery House, The Mall Freeport, BAHAMAS
Attorney information	Brian R. McGinley Dentons US LLP P. O. Box 061080 Chicago, IL 60606-1080 UNITED STATES brian.mcginley@dentons.com, anita.hansen@dentons.com, TTAB@dentons.com

Applicant Information

Application No	86034699	Publication date	01/07/2014
Opposition Filing Date	05/07/2014	Opposition Period Ends	05/07/2014
Applicant	Rosana Meraz 1745 Oro Vista Rd. #240 San Diego, CA 92154 UNITED STATES		


Goods/Services Affected by Opposition


<p>Class 024. First Use: 0 First Use In Commerce: 0</p> <p>All goods and services in the class are opposed, namely: Baby bedding, namely, bundle bags, swaddling blankets, crib bumpers, fitted crib sheets, crib skirts, crib blankets, and diaper changing pad covers not of paper; Baby blankets; Bed and table linen, wall hangings of textile; Bed blankets; Bed canopies; Bed covers; Bed linen; Bed linen and table linen; Bed pads; Bed sheets; Bed sheets of paper; Bed sheets, fitted bed sheet covers, bed flat sheets, and pillow cases used in the bedding, health care, home-health care and nursing home industries made of biodegradable film created from renewable bio-polymer resources; Bed skirts; Bed spreads; Bed throws; Children's bed sheets, pillow cases, and blankets; Fitted bed sheets; Pillow-top, low-profile bed skirts; Silk bedblankets; Table and bed linen</p>
<p>Class 025. First Use: 0 First Use In Commerce: 0</p> <p>All goods and services in the class are opposed, namely: Babies' pants; Baby bibs not of paper; Baby bodysuits; Baby bottoms; Baby bunting; Baby doll pyjamas; Baby layettes for clothing; Baby tops; Bed jackets; Clothing for babies, toddlers and children, treated with fire and heat retardants, namely, pajamas, jackets, shirts, pants, jumpers; Hats for infants, babies, toddlers and children; Hooded sweat-shirts for babies, adults, children; Plastic baby bibs; Shirts for infants, babies, toddlers and children; Sweatshirts for babies, adults, children; T-shirts for babies, adults, children</p>

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1384447	Application Date	08/15/1985
Registration Date	02/25/1986	Foreign Priority Date	NONE
Word Mark	KANGAROOS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1980/02/00 First Use In Commerce: 1980/02/00 FOOTWEAR		

U.S. Registration No.	2096350	Application Date	05/17/1995
Registration Date	09/16/1997	Foreign Priority Date	NONE
Word Mark	KANGAROOS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use: First Use: 0 First Use In Commerce: 0 bags, namely, all purpose sports bags, handbags, purses, rucksacks, satchels, traveling bags, duffel bags, garment bagsfor travel, backpacks; briefcase type portfolios, attache cases, wallets, briefcases, trunks for traveling, suitcases; umbrellas and parasols</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0 footwear, shoes, sports boots, sports shoes; clothing, namely, headwear, hosiery, hats, headbands, jackets, jerseys, jumpers, leggings, shirts, shorts, singlets, skirts, socks, sports jerseys, sweaters, sweat shirts, T-shirts not in the nature of underwear, trousers; and water-proof clothing, namely, water proof jackets and coats; athletic wear, namely, warm up suits, sweat shirts and sweat-pants</p>		

	Class 028. First use: First Use: 0 First Use In Commerce: 0 [toys, games and playthings, namely, stuffed toys; gymnastic and sporting articles, namely, elbow guards for athletic use, knee guards for athletic use, shin guards for athletic use]
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U.S. Registration No.	2096351	Application Date	05/17/1995
Registration Date	09/16/1997	Foreign Priority Date	NONE
Word Mark	KANGAROOS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use: First Use: 0 First Use In Commerce: 0 bags, namely, all purpose sports bags, handbags, purses, rucksacks, satchels, traveling bags, duffel bags, garment bagsfor travel, backpacks; briefcase type portfolios, attache cases, wallets, briefcases, trunks for traveling, suitcases; umbrellas and parasols</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0 footwear, shoes, sports boots, sports shoes; clothing, namely, headwear, hosiery, hats, headbands, jackets, jerseys, jumpers, leggings, shirts, shorts, singlets, skirts, socks, sports jerseys, sweaters, sweat shirts, T-shirts not in the nature of underwear, trousers; and water-proof clothing, namely, water proof jackets and coats; athletic wear, namely, warm up suits, sweat shirts and sweatpants</p> <p>Class 028. First use: First Use: 0 First Use In Commerce: 0 [toys, games and playthings, namely, stuffed toys; gymnastic and sporting articles, namely, elbow guards for athletic use, knee guards for athletic use, shin guards for athletic use]</p>		

U.S. Application No.	85741127	Application Date	09/28/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	KANGAROOS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use: First Use: 0 First Use In Commerce: 0 Bags, namely, all purpose sports bags, handbags, purses, rucksacks, satchels, travelling bags, duffel bags, garment bags for travel, backpacks, briefcase type portfolios, attaché cases, wallets, briefcases, trunks for travelling, suitcases;</p>		

	umbrellas and parasols Class 025. First use: First Use: 0 First Use In Commerce: 0 Footwear, shoes, sports boots, sports shoes; clothing, namely, headwear, hosiery, hats, headbands, jackets, jerseys, jumpers, leggings, shirts, shorts, singlets, skirts, socks, sports jerseys, sweaters, sweat shirts, t-shirts not in the nature of underwear, trousers; and water-proof clothing, namely waterproof jackets and coats; athletic wear, namely, warm up suits, sweat shirts and sweat pants
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Attachments	73553613#TMSN.gif(bytes) 74675825#TMSN.gif(bytes) 85741127#TMSN.jpeg(bytes) Notice of opposition to 86034699.pdf(143609 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Brian R McGinley/
Name	Brian R. McGinley
Date	05/07/2014

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of)	
US Serial No 86034699)	
)	
ASCO GROUP LIMITED)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
ROSANA MERAZ)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer Asco Group Limited ("Asco" or "Opposer"), a corporation organized under the laws of the Bahamas, having offices at Chancery House, The Mall, Freeport, Bahamas, believes that it will be damaged by the registration of U.S. Serial No. 86034699 and hereby opposes registration of the same under § 13 of the Lanham Act of 1946, 15 U.S.C. § 1063.

Applicant Rosana Meraz, an individual ("Applicant") filed an application under Section 1(b) of the Lanham Act on August 12, 2013, U.S. Serial No. 86034699, for the standard character mark KANGAROONIE for the following goods: IC 024: Baby bedding, namely, bundle bags, swaddling blankets, crib bumpers, fitted crib sheets, crib skirts, crib blankets, and diaper changing pad covers not of paper; Baby blankets; Bed and table linen, wall hangings of textile; Bed blankets; Bed canopies; Bed covers; Bed linen; Bed linen and table linen; Bed pads; Bed sheets; Bed sheets of paper; Bed sheets, fitted bed sheet covers, bed flat sheets, and pillow cases used in the bedding, health care, home-health care and nursing home industries made of biodegradable film created from renewable bio-polymer resources; Bed skirts; Bed spreads; Bed throws; Children's bed sheets, pillow cases, and blankets; Fitted bed sheets; Pillow-top, low-

profile bed skirts; Silk bed blankets; Table and bed linen; and IC 025: Babies' pants; Baby bibs not of paper; Baby bodysuits; Baby bottoms; Baby bunting; Baby doll pyjamas; Baby layettes for clothing; Baby tops; Bed jackets; Clothing for babies, toddlers and children, treated with fire and heat retardants, namely, pajamas, jackets, shirts, pants, jumpers; Hats for infants, babies, toddlers and children; Hooded sweatshirts for babies, adults, children; Plastic baby bibs; Shirts for infants, babies, toddlers and children; Sweatshirts for babies, adults, children; T-shirts for babies, adults, children. (“Applicant’s Trademark” or the “Application”).

The United States Patent & Trademark Office (“USPTO”) published the Application for opposition in the *Official Gazette* on January 7, 2014, allowing time to oppose the Application up to and including February 6, 2014. Asco thereafter timely requested a ninety-day extension of the opposition deadline, which request was granted, thereby extending the opposition deadline as to Asco to May 7, 2014. Accordingly, Asco has timely filed this Notice of Opposition.

Asco’s Well-Known and Famous Kangaroos Trademark


1. Asco is a well-known manufacturer of a wide range of clothing, footwear and personal accessories, among other things, all of which Asco distributes in the United States and around the world under its famous KANGAROOS trademark (“Asco’s Kangaroos Trademark”). Specifically, Asco has registered and uses its famous Kangaroos Trademark in connection with numerous goods in International Classes 18 and 25, including, without limitation, headwear, hosiery, jackets, jerseys, jumpers, leggings, shorts, singlets, skirts, sports jerseys, sweaters, sweat shirts, athletic wear, golf shirts, jogging shirts, caps, warm up suits, sweatpants, shirts and t-shirts, footwear, wallets, umbrellas, parasols, all purpose handbags, purses, satchels, traveling bags, tote bags, rucksacks, backpacks, duffel bags, garment bags, briefcases, attaché cases,


traveling trunks and suitcases (“Asco Goods”). Many of these goods are sold for use across numerous age groups of consumers, including children.

2. For almost 35 years, Asco has promoted and sold the Asco Goods in the United States under its well-known and famous Kangaroos Trademark. Asco has built a large and profitable business in the United States under the Kangaroos Trademark.

3. The Kangaroos Trademark has been in the marketplace since the late 1970s and has acquired a worldwide reputation. During the 1980s and 1990s, Kangaroos Trademark became an iconic, historical sports brand worn by many American sporting legends, including Walter Payton, Clyde Drexler and Ozzy Smith. KangaROOS became a Top 5 US sports brand during the 1980s and also gained major success in Europe where, in particular it was cited as a Top 10 footwear brand in Germany. Today, the brand is sold in over 60 countries and is renowned for its shoes as seen on www.kangaroos.com.

4. Asco owns several U.S. registrations for its well-known and famous Kangaroos Trademark for a wide variety clothing items, footwear, purses, bags and various other personal accessories. Representative US registrations for Asco's Kangaroos Trademark are identified below:

Kangaroos Trademark	Registration No.	Registration Date	Goods
	1384447	02/25/1986	IC 025: Footwear

Kangaroos Trademark	Registration No.	Registration Date	Goods
	2096350	09/20/1994	<p>IC 018: bags, namely, all purpose sports bags, handbags, purses, rucksacks, satchels, traveling bags, duffel bags, garment bags for travel, backpacks; briefcase type portfolios, attache cases, wallets, briefcases, trunks for traveling, suitcases; umbrellas and parasols</p> <p>IC 025: footwear, shoes, sports boots, sports shoes; clothing, namely, headwear, hosiery, hats, headbands, jackets, jerseys, jumpers, leggings, shirts, shorts, singlets, skirts, socks, sports jerseys, sweaters, sweat shirts, T-shirts not in the nature of underwear, trousers; and water-proof clothing, namely, water proof jackets and coats; athletic wear, namely, warm up suits, sweat shirts and sweatpants</p>
KANGAROOS	2096351	09/16/1997	<p>IC 018: bags, namely, all purpose sports bags, handbags, purses, rucksacks, satchels, traveling bags, duffel bags, garment bags for travel, backpacks; briefcase type portfolios, attache cases, wallets, briefcases, trunks for traveling, suitcases; umbrellas and parasols</p> <p>IC 025: footwear, shoes, sports boots, sports shoes; clothing, namely, headwear, hosiery, hats, headbands, jackets, jerseys, jumpers, leggings, shirts, shorts, singlets, skirts, socks, sports jerseys, sweaters, sweat shirts, T-shirts not in the nature of underwear, trousers; and water-proof</p>

Kangaroos Trademark	Registration No.	Registration Date	Goods
			clothing, namely, water proof jackets and coats; athletic wear, namely, warm up suits, sweat shirts and sweatpants
KANGAROOS	85741127 (Application No.)	09/28/2012 (Application Date)	IC 018: Bags, namely, all purpose sports bags, handbags, purses, rucksacks, satchels, travelling bags, duffel bags, garment bags for travel, backpacks, briefcase type portfolios, attaché cases, wallets, briefcases, trunks for travelling, suitcases; umbrellas and parasols IC 025: Footwear, shoes, sports boots, sports shoes; clothing, namely, headwear, hosiery, hats, headbands, jackets, jerseys, jumpers, leggings, shirts, shorts, singlets, skirts, socks, sports jerseys, sweaters, sweat shirts, t-shirts not in the nature of underwear, trousers; and water-proof clothing, namely waterproof jackets and coats; athletic wear, namely, warm up suits, sweat shirts and sweat pants

5. Beginning at least as early 1980, Asco has used its Kangaroos Trademark in United States interstate commerce on and in connection with shoes. Since at least as early as 1984, Asco also has used the Kangaroos Trademark on an in connection with a vast array of clothing items and personal accessories, such as handbags, briefcases, suitcases and umbrellas. By virtue of Asco's extensive and continuous usage, coupled with substantial sales in interstate commerce and significant promotional and advertising activities, Asco has achieved widespread

recognition with the relevant trade and public of its Kangaroos Trademark for the Asco Goods, creating a substantial and valuable goodwill among the relevant trade and public with respect to the Kangaroos Trademark.

6. Asco began using the Kangaroos Trademark in United States interstate commerce at least as early as 1981 and first obtained registration in the United States in 1986. Such use and registration clearly predates the filing date of the Application. Accordingly, priority is not an issue in this proceeding.

7. Asco also sells and/or has sold bed linens, bed sheets, pillowcases and duvet covers, bed blankets, curtains, cotton fabrics, handkerchiefs, furniture and cushion coverings, household linens, towels and flannels, shower curtains, cloth bunting and the like in IC 024 (see, e.g., U.S. Application No. 78383246 for KANGAROOS (and design)), and other goods made for children and infants (see, e.g., U.S. Application No. 78607077) (collectively, Asco's "Zone of Expansion Goods").

COUNT I: LIKELIHOOD OF CONFUSION

8. Paragraphs 1-7 are incorporated by reference as though fully set forth in this Count I.

9. Applicant's use of Applicant's Trademark for the goods described in the Application so resembles Asco's Kangaroos Trademark and its registrations therefor as to be likely to create confusion, mistake, or deception under § 2 of the Lanham Act, 15 U.S.C. § 1052(d).

10. Applicant's Trademark is nearly identical to Asco's well-known and famous Kangaroos Trademark. The mere addition of "nie" to the end of Applicant's famous and inherently distinctive trademark is far from sufficient to distinguish the marks from one another.

Consumers encountering such a similar "Kangaroo" trademark in connection with Applicant's goods will reasonably believe that such goods are offered or otherwise sponsored or endorsed by Asco.

11. Applicant's IC 025 goods are overlapping and competitive with and substantially identical to Asco's goods associated with its Kangaroos Trademark. Applicant's IC 024 goods are overlapping and competitive with and/or in the zone of natural expansion of Asco. The parties' goods could be purchased by the very same class of purchasers and are or may be sold in the same trade channels as the goods offered by Asco under its Kangaroos Trademark.

12. As the Application has no limitation on trade channels, Applicant's goods are presumed to move through all of the ordinary and usual channels of trade for the goods described in the Application, further exacerbating the likelihood of confusion between Applicant's Trademark and Asco's Kangaroos Trademark.

13. Asco has established considerable goodwill in connection with its Kangaroos Trademark. Having established such goodwill, Asco is entitled to protection against use of confusingly similar marks.

14. If Applicant's Trademark is allowed to register, purchasers are likely to believe that Applicant's Trademark and the goods offered thereunder originated with or are connected or associated with, or sponsored, licensed, endorsed or approved by Asco, all to Asco's detriment. Undoubtedly, registration of Applicant's Trademark will allow Applicant to wrongfully appropriate Asco's valuable goodwill and reputation associated with its Kangaroos Trademark.

COUNT II: DILUTION

15. Asco repeats and realleges the allegations contained in Paragraphs 1 through 14 as though set forth fully herein in this Count II.

16. Asco's Kangaroos Trademark is famous under the Lanham Act.

17. The Application to register Applicant's Mark was filed after Asco's Kangaroos Trademark became famous.

18. Registration of Applicant's Trademark would likely dilute the distinctive quality of the Kangaroos Trademark because the registration of Applicant's Trademark would lessen the capacity of Asco's Kangaroos Trademark to identify and distinguish goods offered exclusively by Asco.

19. Registration of Applicant's Trademark is likely to dilute Asco's Kangaroos Trademark in violation of Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f).

20. As a consequence of all of the foregoing, Asco is likely to be harmed by registration of Applicant's Trademark.

WHEREFORE, Asco believes that as a result of the likelihood of confusion with and likelihood of dilution caused by Applicant's Trademark, Asco will be damaged by the registration of Applicant's Trademark and prays that the Board sustain this Notice of Opposition and refuse with prejudice to register Serial No. 86034699 in connection with all of the goods which Applicant seeks to register in classes 24 and 25.

Asco Group Ltd. hereby appoints Brian R. McGinley, Adam Rehm, Carol Anne Been and Dentons US LLP, P.O. Box #061080, Wacker Drive Station, Willis Tower, Chicago, IL 60606-1080, as its representative upon whom notices and process in proceedings affecting this proceeding may be served.

Respectfully submitted,

DENTONS US LLP

Dated: May 7, 2014

By: /Brian R. McGinley/
Brian R. McGinley
Adam C. Rehm
Carol Anne Been
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Attorneys for Opposer Asco Group Limited

CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing NOTICE OF OPPOSITION to be served upon:

ROSANA MERAZ
1745 ORO VISTA RD APT 240
SAN DIEGO, CA 92154-4508
Applicant

by placing same in an envelope, properly sealed and addressed, with postage prepaid and depositing same with the United States Postal Service on this 7th day of March, 2014.

/Brian R. McGinley/
Brian R. McGinley
Attorney for Opposer

Filed with the TTAB via
ESSTA on May 7, 2014